

REMARKS

Applicants have carefully reviewed the Application in light of the Final Office Action mailed February 5, 2004. At the time of the Final Office Action, Claims 1-9, 13, 14, 16, 18-35, 38-42, and 44-63 were pending. Claims 1 and 63 have been amended to correct various informalities. Applicants respectfully request reconsideration of the pending claims and favorable action in this case.

Section 103 Rejections

The Examiner rejected Claims 1-9, 13, 14, 16, 18-35, 38-42, and 44-63 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,765,140 issued to Knudson et al. ("*Knudson*"). For the reasons discussed below, Applicants believe that the Examiner has failed to prove a prima facie case of obviousness.

In order to establish a prima facie case of obviousness, three requirements must be met: (1) there must be some suggestion or motivation, either in the references themselves or in the knowledge available to one skilled in the art, to modify a reference or combine multiple references; (2) there must be a reasonable expectation of success; and (3) the prior art reference (or combination of references) must teach or suggest all of the claim limitations. In the present case, the Examiner has failed to prove a prima facie case of obviousness for at least two reasons. First, the Examiner has failed to show that *Knudson* teaches, suggests, or motivates a person of skill in the art to modify *Knudson* to produce the claimed invention. Second, assuming for the sake of argument that *Knudson* does suggest, teach, or motivate a person of skill in the art to modify *Knudson* to achieve the claimed invention, *Knudson* fails to teach or suggest each and every element of the claimed invention.

The determination of whether an invention is obvious in view of prior art considers "if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which the subject matter pertains." 35 U.S.C. § 103. The fact that a prior art device could be modified so as to produce the claimed invention is not a basis for an obviousness rejection unless the prior art suggested the desirability of such a modification.

Furthermore, obviousness cannot be established by combining or modifying the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion, or incentive supporting the combination or modification. The M.P.E.P. sets forth a strict legal

standard for finding obviousness based on a combination of references. "Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge [that was] generally available to one of ordinary skill in the art at the time of the invention." M.P.E.P. § 2143.01. Even a determination that it would have been obvious to one of ordinary skill in the art at the time of the invention to try the proposed combination or modification is not sufficient to establish obviousness without a suggestion in the prior art of the desirability of such a combination or modification. Speculation in hindsight that "it would have been obvious" to make the proposed combination or modification because it would be helpful is insufficient to establish obviousness and amounts to impermissible hindsight reconstruction of the applicant's invention.

If "common knowledge" or "well known" art is relied upon by the Examiner to combine or modify the references, the Examiner should provide a reference pursuant to M.P.E.P. § 2144.03 to support such an argument. If the Examiner relied on personal knowledge to supply the required motivation or suggestion to combine or modify the references, the Examiner should provide an affidavit supporting such facts pursuant to M.P.E.P. § 2144.03.

No Teaching, Suggestion, or Motivation to Modify *Knudson*

In the present case, the Examiner has failed to show that *Knudson* provides the requisite teaching, suggestion, or motivation to a person of skill in the art to modify *Knudson* to produce the claimed invention. Specifically, the Examiner fails to point to any portion of *Knudson* that teaches or suggests the desirability of modifying *Knudson* to achieve the advantages of the claimed invention. The Examiner merely states that "it would have been obvious" to a person of skill in the art to modify *Knudson* to achieve the claimed invention. As discussed above, such a statement is insufficient to establish a prima facie case of obviousness and constitutes impermissible hindsight reconstruction of the applicant's invention.

***Knudson* Fails to Disclose, Teach, or Suggest All Elements of the Claimed Invention**

In each of the independent claims, Applicants have specified specific actions being taken on data which are not disclosed, taught, or suggested by *Knudson*. Specifically, Applicants have previously amended Claims 1, 32, and 63 to better define "tactics" and their relationship to "milestone categories" and to describe what actions are taken when a particular

predefined tactic is selected by the user for a particular project. For example, Claim 1 recites that upon such selection of a first tactic, "automatically associating with the particular project at least one milestone having a particular milestone category that was previously associated with the first tactic." Claims 32 and 63 recite similar, although not identical, elements. This feature of the Applicants' invention allows the operator of a project management system to obtain consistent milestone definitions for various types of tactics. As discussed in the specification, such consistency can be particularly helpful in a large organization.

As an example, Figure 15D can be used to illustrate this aspect of the invention. This example is intended to illustrate an embodiment of the claimed invention and not to limit the claims. When dealing with software systems, for example, one tactic associated with a particular project might be to repair an existing system as illustrated. In this example, there are 4 milestone categories associated with the repair of an existing system: assess, modification, test, and implement. In using the present invention, these four milestone categories can be previously associated with the "repair existing system" tactic type. Thus, when a user of the project management system decides that it is necessary to repair an existing system during the project, the user might select the "repair existing system" tactic type from a menu of possible tactic types. At that point, the system may automatically associate four milestones with the project and tactic. Here, the four milestones that may be automatically assigned have the milestone types: assess, modification, test, and implement. By automatically assigning milestone types, the invention saves time in having to enter the milestone information and promotes uniformity in project management.

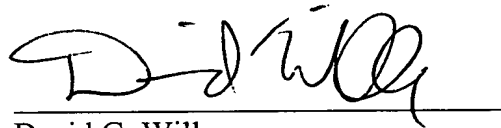
The Examiner states that *Knudson* discloses "automatically associating at least one milestone with a project based on a selected tactic." (Final Office Action mailed 2/5/04, Page 3, citing *Knudson*, Col. 9, Lines 50-54). The cited portions of *Knudson* merely disclose that when a user enters an estimated time to completion of an assigned task, the estimated completion information is fed back into a project planning tool to update the plan. Because neither the claimed invention, nor its advantages are taught or suggested by *Knudson*, Applicants submit that Claims 1, 32, and 63 are patentable. All other pending claims depend upon one of these independent claims, either directly or indirectly, and, therefore, are patentable for the same reasons that Claims 1, 32, and 63 are patentable. Therefore, Applicants respectfully request full consideration of all pending claims.

CONCLUSION

Applicants have now made an earnest attempt to place this case in condition for immediate allowance. For the foregoing reasons and for other reasons clear and apparent, Applicants respectfully request reconsideration and allowance of the pending claims.

Applicants do not believe any fees are due. However, the Commissioner is hereby authorized to charge any additional fees or credit any overpayment to Deposit Account No. 05-0765 of Electronic Data Systems Corporation. If there are matters that can be discussed by telephone to advance prosecution of this application, Applicant invites the Examiner to contact its attorney at the number provided below.

Respectfully submitted,
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